

of all of the presently pending claims, without amendment, in view of the following remarks.

### **REMARKS**

The present invention, as claimed, is directed at a technique to prepare and/or evaluate a business proposal. By way of summary, the claims recite displaying (or having a program configured to display) a plurality of questions that concern the business proposal. At least one database is accessed, answers are received, and a search is performed. An intermediate result concerns selecting at least two business structures from the following group: alliance, acquisition, equity venture, partnership, and venture. After further consideration, a final result concerns ranking at least two of the business structures. All of the claims recite preparing/evaluating a business proposal by selecting at least two of an alliance, an acquisition, an equity venture, a partnership, and a venture.

U.S. Patent 6,957,191 (Belcsak et al.), the primary reference cited by the Examiner, does not disclose preparing/evaluating a business proposal by selecting at least two of an alliance, an acquisition, an equity venture, a partnership, and a venture. Belcsak et al. discloses "an automated tool for modeling the cash flows of financial scenarios . . ." col. 1, lines 15 and 16. The financial scenarios concern financial transactions and arrangements between parties of a purchase, as is made clear throughout the specification.

### **Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected all of the claims under 35 U.S.C. §103(a) in view of Belcsak et al. Applicants respectfully traverse the rejections.

## Claim 1

Claim 1 states:

A method of preparing and evaluating a business proposal, comprising the steps of:

displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment;

allowing access to a database of client information and a database of proposer information;

receiving answers to the plurality of questions based on information accessed in the databases;

defining a query for search criteria for the proposal;

performing a search based on the query and answers to the questions;

storing information relevant to the proposal gathered in the search;

*selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture;*

evaluating the stored information by computer;

ranking the at least two alternative structures based on the evaluation of the stored information;

outputting a report displaying the rankings and responses to at least one of the questions;

reevaluating information sources and a business environment relative to the proposal;

reevaluating organizational and proposal considerations, and risks relative to the proposal;

reconsidering at least one of the alternative structures and optionally reshaping at least one of the alternative structures; and

reevaluating and re-ranking the at least two alternative structures (emphasis added).

The Examiner states that the selecting limitation is disclosed at col. 7, lines 6-9 and 29-35, col. 10, lines 14-36, and col. 11, lines 59-62. Applicants respectfully disagree.

The Belcsak et al. disclosure references business structures only once. Specifically, col. 11, lines 59-62 state:

In addition to general financial instruments, the system may also include instruments for advanced corporate finance operations, such as mergers, acquisitions and the like.

Belcsak et al. mentions mergers and acquisitions merely as examples of operations having financial instruments that can be modeled by the disclosed tool. The purpose of the examples is to provide the reader with an understanding that there are different types of financial instruments, from different sources, that can be modeled by the tool. Mergers and acquisitions are examples of sources of financial instruments.

Belcsak et al. does not address, or provide means for, selecting one or two business structures/operations over others. The section referenced above certainly does not disclose selecting a merger or an acquisition. **Moreover, Belcsak et al. does not suggest that modeling a financial instrument would be of any assistance or could be used for selecting any business structure/operation over another.** In other words, modeling a financial instrument as is suggested in Belcsak et al. for use in a merger bears no relationship to selecting the merger over other operations in the first place. Belcsak et al. indiscriminately states that the tool can be used to model an instrument, such as for use with mergers, acquisitions or the like. Belcsak et al. does not disclose selecting one or the other, or any other business structure.

It would not have been obvious to one of ordinary skill in the art to modify Belcsak et al. to include the selecting step of claim 1. Specifically, one of ordinary skill in the art would not look to the Belcsak et al. disclosure for a method or apparatus to select a business structure/operation because there is nothing in Belcsak et al. or the prior art to suggest that the Belcsak et al. tool could be used to compare, rank and select one business structure/operation for reshaping over another. Further, there is no

express or implied suggestion to combine Belcsak et al. with another reference for selecting a business structure/operation. Finally, the Examiner has not suggested that Belcsak et al. could be modified to select a business structure/operation, and has not shown that any such modifications would be possible.

In addition to the above, claim 1 recites selecting at least two of an alliance, an acquisition, an equity venture, a partnership, and a venture. Belcsak et al. does not disclose selecting two members of that group over the other members of that group.

The tenth limitation of claim 1 states:

outputting a report displaying the rankings and responses to at least one of the questions

The Examiner states that the outputting limitation is obvious because it is old and well known to display rankings to a user for the user's benefit. Applicants do not agree with the Examiner's interpretation of this limitation.

The outputting step, read in its entirety, is for outputting a report displaying the rankings and *responses to at least one of the questions*. The Examiner has not asserted that the reference discloses a display showing rankings *and* a response to a question for a business proposal, and has not asserted that doing so is an obvious step in view of the reference.

In order to establish a *prima facie* case of obviousness, "all the claim limitations must be taught or suggested by the prior art." See MPEP § 2143.03. It would not have been obvious to one skilled in the art to modify Belcsak et al. to select at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture, as recited in claim 1. Also, the Examiner has not asserted that the prior art, including Belcsak et al., discloses outputting a report displaying the rankings and responses to at least one of the questions. The Examiner has not asserted that it would have been obvious to do so in light of Belcsak et al. Hence, claim 1 is allowable.

Claims 3, 4, 7, 8, 12-17, 39-44, and 49-54 depend on claim 1 and are also allowable for at least the same reasons.

**Claims 18, 22-26, 28-38, and 45-58**

The Examiner summarily rejected the remaining claims, including independent claims 18 and 32, stating that the claims recite substantially similar subject matter as claims 1, 3, 4, 7, 8, 12-17 and 39-44. Applicants disagree with the Examiner's rejection.

Claim 18 is believed allowable for the same reasons that claim 1 is. Specifically, the "selecting" step of Claim 18 recites:

selecting at least two alternative structures . . . selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

which is similar to the language of claim 1 discussed above.

Claim 32, an apparatus claim, recites:

a computer program residing in said computer or in said memory, wherein the proposal [being evaluated] includes a plurality of alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

which is also similar to the language of claim 1.

As stated above, Belcsak et al. does not raise the issue of selecting one or two business structures/operations over others. The Examiner has not shown that such limitations of claims 18 and 32 are taught, suggested, or made obvious by the prior art. Hence, claims 18 and 32 are allowable.

Claims 22-26, 28-31, 46-48, 55 and 56, and claims 33-38, 57, and 58 depend on claims 18 and 32, respectively, and are allowable for at least the same reasons as the claims upon which they depend.

In addition, claim 22 recites subject matter not examined in any of the examined claims 1, 3, 4, 7, 8, 12-17 and 39-44. Claim 22 provides:

The method of claim 18, further comprising a step of entering information concerning strength of a business relationship by entering a number from 1 to 5, and wherein the step of calculating the advantage of the structures is based on the entered information concerning the strength of a business relationship.

Belcsak et al. does not disclose "calculating the advantage of the structures . . . based on the entered information concerning the strength of a business relationship." Although Belcsak et al. suggests that the strength of a business relationship may factor into a model of cash flows between parties, such as a preferred interest rate or the like, it does not mention or suggest calculating the advantage of a merger over an acquisition, for example, based upon the strength of a business relationship. The Examiner has not stated or suggested that it would have been obvious to modify Belcsak et al. to use the strength of a business relationship to prepare or evaluate a business structure/operation, and has not shown that any such modifications would be possible.

Claim 22 is believed allowable because it recites subject matter not disclosed in, or made obvious by Belcsak et al.

Accordingly, Applicants respectfully request that the claim rejections under 35 U.S.C. § 103(a) be withdrawn.

### **Conclusion**

Therefore, in view of the above remarks, Applicants respectfully submit that this application is in condition for allowance and such action is earnestly requested.

If for any reason the Examiner is not able to allow the application, she is requested to contact the Applicants' undersigned attorney at (312) 321-4200.

Respectfully submitted,

A handwritten signature in cursive script, reading "John R. Lagowski", is written over a horizontal line.

John R. Lagowski  
Registration No. 41,922  
Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200